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10/053,667	01/24/2002	Hidehiko Kawakami	11-078	8425

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SUITE 101
RESTON, VA 20191

EXAMINER

BOVEJA, NAMRATA

ART UNIT	PAPER NUMBER
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3622

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11/19/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/053,667

Applicant(s)

KAWAKAMI, HIDEHIKO

Examiner

Namrata Boveja

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 1-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to communication filed on 08/30/2007.
2. Claims 1-17 have been cancelled. Claims 18-27 are presented for examination.
3. Amendments to the claims have been entered and considered.

Claim Rejections - 35 USC § 112

4. *The second paragraph of 35 U.S.C. 112 is directed to requirements for the claims:*

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

There are two separate requirements set forth in this paragraph:

- (A) the claims must set forth the subject matter that applicants regard as their invention; and*
- (B) the claims must particularly point out and distinctly define the metes and bounds of the subject matter that will be protected by the patent grant.*

Claims 19 and 25 are rejected under 35 U.S.C. 112, second paragraph, since the recitation "setting means for setting....information that is prohibited from being used" renders the claim indefinite, because it is unclear what the Applicant means by "setting means". It is interpreted to mean that the permission or refund flag is set to indicate that the content is unused or used and that the Applicant is referring to the setting of the flags. Appropriate correction is required.

5. *Claims 21 and 27 are rejected under 35 U.S.C. 112, second paragraph, since the recitation "the road map is divided into a plurality of zones, which correspond to the parts" renders the claim indefinite, because it is unclear what the Applicant means by "zones correspond to the parts". For example, it is unclear if each zone is a part. It is*

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interpreted to mean that the road map is divided into a plurality of areas. Appropriate correction is required.

6. *Claim 24 rejected under 35 U.S.C. 112, second paragraph, since the claim appears to be an incomplete recitation, as there is nothing recited after "and," and this renders the claim indefinite, because it is unclear if the Applicant meant to include anything after the word "and." It is interpreted to mean that the Applicant intended to end the claim before the word "and." Appropriate correction is required.*

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. *Claims 18, 24, and 26 are rejected under 102(b) as being anticipated by Torii et al. (Patent Number 5,761,308 hereinafter Torii).*

In reference to claim 18, Torii teaches an information providing system for providing an information package containing purchased information from an information vendor to a user who has an information consuming device, wherein the information package includes a plurality of information parts, and wherein the information package is in a condition for use by the user after the user pays for the whole information package and installs the information package on the information consuming device, comprising: identifying means for identifying actually unused parts or an unused part of

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the purchased information (i.e. whether specific content from the CD has been normally installed) (col. 4 lines 47-52, col. 7 lines 44-54, col. 10 lines 24-52, col. 13 lines 25-55, and Figure 3); and refunding means for processing a refund payment for the actually unused parts or unused part to the user (abstract, col. 3 lines 34 to col. 4 lines 65).

8. *In reference to claim 24, Torii teaches a method of providing an information package containing purchased information from an information vendor to an user who has an information consuming device, wherein the information package includes a plurality of parts, and wherein the information package is set to be in a condition for use after the user pays for the whole information package and installs the information package on the information consuming device, comprising: identifying actually unused parts or an unused part of the purchased information package (i.e. whether specific content from the CD has been normally installed) (col. 4 lines 47-52, col. 7 lines 44-54, col. 10 lines 24-52, col. 13 lines 25-55, and Figure 3).*

9. *In reference to claim 26, it is inherent that Torii teaches the information providing system, wherein the information consuming device comprises a payment calculating means for calculating an amount of the refund payment that is paid from the information, vendor to the user through the refund processing means (i.e. payment for the unused portion is processed) (col. 3 lines 57 to col. 4 lines 3 and col. 4 lines 32-37).*

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. *Claims 19 and 20 are rejected under 103(a) as being anticipated by Torii in view of Official Notice.*

In reference to claim 19, Torii teaches using a check code to determine if the user should be able to receive a refund) (col. 3 lines 12 to col. 5 lines 26). Torii does not teach the information providing system, further comprising setting means for setting (i.e. setting the flag to indicate) the actually unused part or unused parts that is identified by the identifying means and for which a refund payment has been accepted by the user through the refund processing means as information that is prohibited from being used.

Official Notice is taken that it is old and well known to set the flag on items for which a refund has been accepted by the user as information that is prohibited from being used to prevent the user from receiving a refund twice for a single item. For example, when a user goes to a retailer to return something and the barcode on the receipt is scanned, once the item has been returned, the user will not be able to return it again, since it would show up as already been returned in the register. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to set the flag to indicate that the user has received a refund already for the unused part to prevent the return of an already returned file and therefore to prevent fraud by a user, which is one of Torii's objectives.

11. *In reference to claim 20, it is inherent that Torii teaches the information providing system, wherein the information consuming device comprises a payment calculating*

means for calculating an amount of the refund payment that is paid from the information, vendor to the user through the refund processing means (i.e. payment for the unused portion is processed) (col. 3 lines 57 to col. 4 lines 3 and col. 4 lines 32-37).

12. *Claims 21 and 22 are rejected under 103(a) as being anticipated by Torii in view of Applicant's background.*

In reference to claim 21, Torii teaches the information providing system (col. 4 lines 38-46). Torii does not teach the system wherein the information consuming device is located in a vehicle, the information package is a road map, and the road map is divided into a plurality of areas. Applicant's background on page 1 lines 12-29 teach the system wherein the information consuming device is located in a vehicle, the information package is a road map, and the road map is divided into a plurality of areas. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps to provide for customized billing for the use of individual area maps similar to customized billing for use of each song and to provide the map information in a consuming device located in a vehicle, since a user is most likely in need of directions when he is driving in a vehicle.

13. *In reference to claim 22, Torii teaches the information providing system, wherein the refund payment is a function of the unused parts of supplied software that have not been used by the user (col. 3 lines 57-61 and col. 4 lines 33-37). Torii does not teach the unused software to include the number of the zones of the road map that have not been used by the user. Applicant's background on page 1 lines 12-22 teaches selling*

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maps on CD's. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps with number of zones to provide for customized billing for the use of individual area maps for each zone similar to customized billing for use of each song.

14. *Claims 23, 25, and 27 are rejected under 103(a) as being anticipated by Torii in view of Applicant's background and further in view of Official Notice.*

In reference to claim 23, Torii teaches the information providing system wherein the information consuming device communicates with the information vendor via a communication network (col. 1 lines 6-21). Torii does not teach the communication taking place via a wireless communication. Official Notice is taken that it is old and well known to use a wireless communication to communicate to vendors to enable users to connect via a variety of handheld devices such as PDA's, cell phones, and laptops. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to include the use of wireless communication for communicating with vendors to provide the users the flexibility in connecting to vendors from various mobile devices in addition to the user's personal computer system.

15. *In reference to claim 25, Torii teaches using a check code to determine if the user should be able to receive a refund) (col. 3 lines 12 to col. 5 lines 26). Torii does not teach the information providing system, further comprising setting means for setting (i.e. setting the flag to indicate) the actually unused part or unused parts that is identified by the identifying means and for which a refund payment has been accepted by the*

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user through the refund processing means as information that is prohibited from being used.

Official Notice is taken that it is old and well known to set the flag on items for which a refund has been accepted by the user as information that is prohibited from being used to prevent the user from receiving a refund twice for a single item. For example, when a user goes to a retailer to return something and the barcode on the receipt is scanned, once the item has been returned, the user will not be able to return it again, since it would show up as already been returned in the register. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention for Torii's invention to set the flag to indicate that the user has received a refund already for the unused part to prevent the return of an already returned file and therefore to prevent fraud by a user, which is one of Torii's objectives.

16. *In reference to claim 27, Torii teaches the information providing system (col. 4 lines 38-46). Torii does not teach the system wherein the information consuming device is located in a vehicle, the information package is a road map, and the road map is divided into a plurality of areas. Applicant's background on page 1 lines 12-29 teach the system wherein the information consuming device is located in a vehicle, the information package is a road map, and the road map is divided into a plurality of areas. It would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include in Torii's invention an information package consisting of maps to provide for customized billing for the use of individual area maps similar to customized billing for use of each song and to provide the map information in a*

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consuming device located in a vehicle, since a user is most likely in need of directions when he is driving in a vehicle.

Response to Arguments

17. After careful review of Applicant's remarks/arguments filed on 08/30/2007, the Applicant's arguments with respect to claims 18-27 are presented for examination and have been fully considered but are moot in view of the new ground(s) of rejection.

Amendments to the drawings and claims have been entered and considered.

18. Applicants additional remarks are addressed to new limitations in the claims and have been addressed in the rejection necessitated by the amendments.

19. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The **FAX** number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

NB

November 9th, 2007

Yehdega Retta
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